

## REMARKS

The Office Action dated December 12, 2006, has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

Claims 1-22 and 98 are currently pending in the application, of which claims 1 and 98 are independent claims. Claims 1-8 and 12-22 have been amended, and claim 98 has been added, to more particularly point out and distinctly claim the invention. No new matter has been added. Claims 23-97 have been canceled without prejudice or disclaimer. Claims 1-22 and 98 are respectfully submitted for consideration.

Claims 1, 12, and 37-39 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite because claim 1 recites “configured” and because claims 12 and 37-39 recite “at least partially comprises a wireless communication part.” Claims 37-39 have been cancelled without prejudice or disclaimer, and, thus, their rejection is moot.

The Office Action took the position that “configured” in claim 1 does not create a positive recitation and is optional language. Applicant respectfully traverses this objection.

The use of the verb “to configure” does not make the associated claim language optional, and is an acceptable way of claiming an invention. Since 1976, more than 200,000 patents have issued that contain the words “configured” or “configuring” in the claims. The use of the verb “to configure,” therefore, can be seen to be a widely accepted

word for claiming inventions. Furthermore, there is nothing “optional” about configuration.

Moreover, Applicant notes that the Examiner’s Supervisor, Wellington Chin, has allowed more than 350 patents whose claims include the recitation of “configured.” Accordingly, Applicant respectfully submits that it should be well known to the Examiner that the use of the term “configured” is an acceptable, non-optional way of claiming inventions.

Likewise, Applicant notes that the Examiner, as an Assistant Examiner, has apparently previously allowed patents whose claims include the recitation of “configured.” Accordingly, Applicant respectfully submits that the Examiner’s objection to the use of the verb “to configure” to claim the invention is not reasonable. Therefore, Applicant respectfully requests that this rejection be withdrawn.

With regard to claim 12, claim 12 has been amended, and it is respectfully submitted that the rejection of claim 12 is moot in view of the amendment. Thus, withdrawal of the rejection of claim 12 is respectfully requested.

Claims 1-6, 8-16, 18-20, 22-31, 37-72, and 85-97 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,636,502 of Lager et al. (“Lager”). Applicant respectfully traverses this rejection as applied to claims 1-6, 8-16, 18-20, and 22 and notes that the rejection is moot as to claims 23-31, 37-72, and 85-97, because claims 23-31, 37-72, and 85-97 have been canceled without prejudice or disclaimer.

Claim 1, upon which claims 2-22 depend, is directed to a network element between a first internet protocol based network and a second external packet data network. The network element includes a first interface configured to communicate with said first internet protocol based network using an internet protocol to receive signals from and send signals to the first network. The first internet protocol based network is a private computer based network comprising wireless capabilities that are implemented in a cellular communications terminal. The interface is configured such that internet protocol traffic intended for a wireless user within said first internet protocol based network from another wireless user within said first network can occur without any signaling occurring externally of said first network. The network element also includes a second interface configured to communicate with said second network via an internet protocol based connection to receive signals from and send signals to the second packet data network.

Certain embodiments of the present invention are concerned with a network element that is configured to sit between an IP based network and a second packet data network. In these embodiments, the first IP based network is effectively a private network such as a corporate network. The second packet data network, in the preferred embodiment is a GPRS network.

In these example embodiments, the network element is designed such that a wireless terminal in the first network can advantageously communicate with another wireless user in that same private network without any signalling occurring externally of

the network. Thus, one user in the first network can advantageously make an internet protocol (IP) call to a user in that same network without having to have signalling going externally of the network.

Applicant respectfully submits that Lager fails to disclose or suggest all of the elements of any of the presently pending claims, and, therefore, cannot provide the critical and unobvious advantages discussed above.

Lager generally relates to GPRS-subscriber selection of multiple internet service providers. Lager is not particularly relevant to the presently pending claims.

For example, the Office Action took the position that, in Figure 8 of Lager, the element referred to as PLMN-SW corresponds to the “network element” recited in claim 1. Applicant respectfully disagrees.

Claim 1 recites that the network element interfaces between a first internet protocol (IP) based network and a second packet data network (“comprising: a first interface ... and a second interface”). Thus, specifically, the network element is recited as having a first interface that communicates with the first IP based network using an IP protocol to receive signals from and send signals to the first network. The first IP based network is defined as being a private computer based network comprising wireless capabilities that are implemented in a cellular communications terminal. The interface is configured such that wireless traffic intended for a user within the first IP based network from another wireless user within the first network can occur without any signalling occurring externally of the first network. Referring to Figure 8 of Lager, the Office

Action has identified the corporate network as corresponding to the recited “first network.”

The Office Action has asserted that the network element is regarded as being the PLMN-SW entity. Applicant notes that PLMN stands for Public Land Mobile Network. A PLMN is, therefore, not a private computer based network or part of such a network. Instead, the PLMN-SW is part of a second network, and, therefore, not between “a first IP based network and a second packet data network” as recited in claim 1. The traffic from the first network would need to leave the first network (*i.e.* PDN 2) to get to the PLMN-SW entity. In consequence, PLMN-SW cannot possibly correspond to the claimed “network element.”

Furthermore, even if the claimed “network element” of claim 1 were made to correspond to the PDN-SW of the corporate network, there is no disclosure that the PDN-SW includes a first interface that is configured to permit communication to occur between two users in the private computer based network without any signalling occurring externally to the first network.

Accordingly, it is respectfully submitted that Lager fails to disclose or suggest the claimed “network element.” Thus, it is respectfully requested that the rejection of claim 1 be withdrawn.

Claims 2-6, 8-16, 18-20, and 22 depend from and further limit claim 1. It is, therefore, respectfully submitted that each of claims 2-6, 8-16, 18-20, and 22 recites

subject matter that is neither disclosed nor suggested in the cited art. Thus, it is respectfully requested that the rejection of claims 2-6, 8-16, 18-20, and 22 be withdrawn.

Claims 7, 17, 21, 32-36, and 73-84 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lager in view of U.S. Patent No. 7,085,257 of Karves et al. (“Karves”). Applicant respectfully traverses this rejection as applied to claims 7, 17, and 21 and notes that the rejection is moot as to claims 32-36 and 73-84, because claims 32-36 and 73-84 have been canceled without prejudice or disclaimer.

Karves is not prior art to the present application. Karves was filed April 6, 2000, which is later than the effective filing date of the present application (June 4, 1999). The present application is entitled to the priority of PCT/IB00/00840, filed June 20, 2000, and GB9913102.1 filed June 4, 1999. Priority has been properly claimed under 35 U.S.C. 119, and acknowledgement of receipt of all certified copies of the relevant priority documents was made by the USPTO in an Office Action on December 21, 2005.

Thus, the present application antedates Karves, and it is respectfully requested that the rejection be withdrawn.

Furthermore, Applicant respectfully traverses the taking of Official Notice on page 5 of the Office Action. Applicant traverses this taking of Official Notice because it is moot both because the rejection cannot stand without Karves, and because the Official Notice states: “dual mode terminal [sic] are commercially available.” Whether or not such terminals are commercially available is irrelevant to the appropriate inquiry, which

is the state of the art at the time of the invention. Thus, it is respectfully requested that the Official Notice be withdrawn.

For all the reasons explained above, it is respectfully submitted that each of claims 1-22 and 98 recite subject matter that is neither disclosed nor suggested in the cited art. It is, therefore, respectfully requested that all of claims 1-22 and 98 be allowed, and that this application be passed to issuance.

If, for any reason, the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, Applicant's undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

  
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